

REMARKS

INTRODUCTION

In accordance with the following, reconsideration of the pending claims is respectfully requested.

Claims 1-18 are pending and under consideration, noting that claims 7 and 8 have been allowed.

REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION

The outstanding Office Action indicates both that the outstanding Office Action was made final and that the Applicant's previous remarks to the previous Office Action were moot in view of the Examiner's new grounds for rejection.

However, it is respectfully submitted that the outstanding Office Action cannot be made final unless Applicant's previous amendments necessitated the same, i.e., by raising new issues or by requiring an additional search.

Rather, in the last amendment to the previous Office Action, independent claim 1 was amended to include features from dependent claim 3, which merely included "wherein the elastic member is a viscoelastic material having a damping characteristic." This feature had previously been considered by the Examiner, and in particular, the Examiner had previously indicated that Yoshiyuki, JP 2002-279739, already disclosed the same. Also see the previous amendment to claim 10, which also did not raise and new issues or require a new search.

Similarly, dependent claims 3, 4, 7, 11, and 13 were merely amended into independent form. Here, as these claims are the same as the original claims, any new rejection rationale must only be presented in a non-final Office Action.

Thus, as the Office Action has indicated that the present rejections are new rejections, the outstanding Office Action cannot be made final. In particular, the Office Action has withdrawn the previous interpretation of Yoshiyuki as disclosing the elastic member being viscoelastic. See page 3 of the Office Action mailed July 11, 2005.

Accordingly, withdrawal of the finality of the outstanding Office Action is respectfully requested.

REQUIRED RESPONSE TO APPLICANT'S PREVIOUS REMARKS

Applicants further respectfully submit that the outstanding Office Action is improper. The Office Action has not responded to remarks presented by Applicants in previous responses. A new non-final Office Action is respectfully requested, with the same including a detailed explanation of why Applicant's proffered non-obviousness remarks are not persuasive. Such an analysis is requested for remarks presented in the previous response to the previous Office Action, any intervening response, and the outstanding response.

The outstanding Office Action has essentially set forth an identical rejection of the claimed invention, except for whether an elastic member within Yoshiyuki is viscoelastic or not, i.e., the outstanding rejection is based on an identical underlying interpretation of Yoshiyuki for all the claimed features except for the viscoelastic member.

Further, Applicants had previously set forth a detailed explanation of the features within Yoshiyuki, including providing the Examiner with a mechanical translation of the underlying Yoshiyuki Japanese language reference. In particular, Applicants had pointed out that the Examiner's interpretation of Yoshiyuki was incorrect and not possible, in view of the disclosure of Yoshiyuki.

However, the outstanding Office Action fails to address any of Applicants remarks, as well as failing to acknowledge the provided English translation of Yoshiyuki.

To this matter, regarding the use of foreign language abstracts, the court in Ex parte Gavin noted: "[i]n this appeal, the examiner relied upon abstracts of two published Japanese patent applications without referring to translations of the underlying applications. An abstract and the underlying document of which it is a summary are distinct documents. In a rejection, an abstract stands on its own—it does not incorporate by reference any disclosure of the underlying document. Abstracts are often not written by the author of the underlying document, and may be erroneous or misleading—in virtually all cases, they are incomplete." Ex parte Gavin, 62 USPQ2d 1680, 1683 (BPAI 2001).

"Generally an abstract does not provide enough information to permit an objective evaluation of the validity of what it describes. Thus, an abstract is even less reliable a basis to extrapolate the alleged teachings of the underlying document to different circumstances. Abstracts function to alert a reader to disclosures of possible interest. They are little more reliable than headlines or brief newspaper articles. Citation of an abstract without citation and reliance on the underlying scientific document itself is generally inappropriate where both the abstract and the underlying document are prior art. It is our opinion that a proper examination

under 37 CFR §1.104 should be based on the underlying documents and translations, where needed. Accordingly, the preferred practice is for the examiner to cite and rely on the underlying document." Id. at 1684.

Thus, the Examiner should have acknowledged Applicant's provided English language translation and pointed out in the same where the underlying reference disclosed the claimed invention, as well as wherein Yoshiyuki there was support for the Examiner's interpretation Yoshiyuki disclosing the claimed features, as proffered by the Examiner.

Rather, similar to above, the Office Action has failed to respond to Applicant's remarks.

As noted in at least MPEP 707.07(f), **the Examiner is required to answer and address all traversals. This requirement is in addition to any repetition of a previously held position and is required to allow the applicant a chance to review the Examiner's position as to these arguments and to clarify the record for appeal.**

Additionally and as further noted in MPEP 707.07(f), a failure of the Examiner to address the applicant's traversals can be deemed a failure to rebut these arguments so as to admit that the arguments have overcome the rejection. At the very least, the failure to address the applicant's traversals would render the Examiner's decision to again reject the claims arbitrary and capricious and invalid under the Administrative Procedures Act, 5 U.S.C. § 706, the standard under which such rejections are reviewed in view of Dickinson v. Zurko, 527 U.S. 150, 50 USPQ2d 1930 (1999).

As such, since the Examiner has not addressed the applicant's traversals presented in the previous Amendment to the previous Office Action, it is respectfully requested that the Examiner both withdraw the Final Office Action and issue a new Office Action addressing the previous remarks to the previous Office Action, as well as those presented herein and any intervening submission.

REJECTION UNDER 35 USC 102

Claims 1-6 and 9-18 stand rejected under 35 U.S.C. 102(e) as being anticipated by Yoshiyuki, JP 2002-279739. This rejection is respectfully traversed.

In Applicant's "Request For New Office Action," filed December 29, 2005, Applicants noted that the outstanding § 102 rejection appeared incorrect, as it set forth obviousness rationales. A copy of this filing is enclosed.

In the "Request For New Office Action," Applicants further pointed out the impropriety

of the proffered obviousness rejections and taking of Official Notice. Both remarks are incorporated herein.

Further, regarding the obviousness rationale presented by the Examiner, it is respectfully submitted that the present invention sets forth different physical arrangement from that of Yoshiyuki, with the claimed invention corresponding to the present invention.

The Office Action would appear to be attempting to force Yoshiyuki to read on the presently claimed invention, when there would not appear to be any need or desire to modify Yoshiyuki.

In addition, for completeness, Applicant's previous remarks are again repeated hereinbelow.

As explained in Yoshiyuki, there are only two disclosed or suggested flat springs 4a and 4b, with flat springs 4a and 4b sequentially providing respective elastic forces against the rack 3, and with the rack 3 contacting the spiral groove. The rack 3 is not an elastic body and is used only as a conventional mechanism to interact with the spiral groove and the optical pickup.

In the presently claimed invention, the rack 3 can only be interpreted as corresponding to the claimed contact parts, e.g., see claim 1, "one or more contact parts engaging the spiral groove formed on the lead screw, and applying a force to the optical pickup unit in response to the rotation of the lead screw, wherein the force moves the optical pickup unit." All independent claims include a reference to contacts parts.

Accordingly, it is respectfully submitted that the rack 3 of Yoshiyuki can only correspond to the claimed contact parts.

The Office Action indicates on page 3 that the rack 3 of Yoshiyuki can also be interpreted as the claimed elastic member and/or the first elastic section. **Again, it is noted that the Office Action has interpreted rack 3 of Yoshiyuki as being both the claimed guide member and the claimed elastic member.**

However, the rack 3 is not an elastic body, and as illustrated in Yoshiyuki, rack 3 is a separate body from flat springs 4a and 4b. Further, the rack 3 would not have been an elastic body, since the purpose of the rack 3 is to firmly engage the spiral screw. The flat springs 4a and 4b perform the elastic function of either forcing rack 3 toward the spiral screw or prevent the rack 3 from jumping out of the spiral screw grooves.

Thus, rack 3 should not be interpreted as an elastic body. Accordingly, Yoshiyuki can only be interpreted as including two elastic sections/bodies.

Lastly, the Office Action has indicated that the elastic member of Yoshiyuki “is a viscoelastic material having a damping characteristic (inherent).”

However, Yoshiyuki only discloses “elastic” bodies. The flat springs of Yoshiyuki are not viscoelastic bodies. Viscoelastic solids are solids that provide both elastic properties and viscous properties. As described in the attached discussion of “Viscosity,” the first paragraph on page 5 details that “[m]aterials for which both their viscosity and their elasticity are important in a particular range of deformation and deformation rate are called viscoelastic.”

Thus, though the flat springs 4a and 4b of Yoshiyuki are elastic bodies, they do not have any substantial viscous properties. Conversely, embodiments of the present invention set forth particular examples of bodies that have both substantial elastic and viscous properties, i.e., viscoelastic materials. It is respectfully submitted that Yoshiyuki further fails to provide any support or disclosure suggesting the same.

Accordingly, independent claims 1, 9, 10, 16, and 17 all claim that the elastic member is a viscoelastic material. It is respectfully submitted that Yoshiyuki fails to disclose or suggest the claimed viscoelastic material. Conversely, as noted above, embodiments of the present application solve similar problems as those in Yoshiyuki, but in different manners, and in different ways. Yoshiyuki would not be open to the viscoelastic material feature of claims 1, 9, 10, 16, and 17, without using the present application as motivation for the same.

Further, it is respectfully submitted that the claimed third elastic section of independent claims 4 and 13 similarly are not disclosed by Yoshiyuki. As noted above, Yoshiyuki only discloses two elastic bodies. Further, there would not be any need for an additional elastic body in Yoshiyuki, as the existing two elastic bodies perform the desired operation. There is no suggestion in Yoshiyuki how a third elastic body would be implemented and what purpose the same would achieve.

Lastly, independent claims 2 and 11 set forth that the second elastic section is formed by a body, and that “at least one protrusion from the body forming the first elastic section.” The Office Action would appear to set forth that the teeth of the rack 3 engaging the spiral screw meets the claimed protrusion.

However, as noted above, the rack 3 is not an elastic body. Thus, as neither flat spring 4a or 4b form a body from which the other flat spring 4a or 4b protrudes from, Yoshiyuki cannot be considered as disclosing this claimed feature. Yoshiyuki can only be considered as disclosing or suggesting two distinct elastic spring bodies, failing to disclose or suggest that one elastic body will protrude from the other elastic body.

Therefore, it is respectfully submitted that all pending claims are patentably distinguishable over Yoshiyuki. Accordingly, it is respectfully submitted that claims 1-18 are in allowable condition, and withdrawal of these rejections is respectfully requested.

CONCLUSION

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

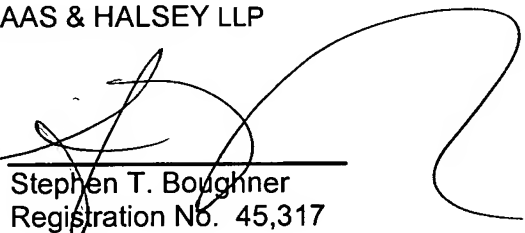
Respectfully submitted,

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1/6/06

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